

Application No. 10/609,636
Amdt. Dated September 1, 2004
Reply to Office Action of May 17, 2004

Remarks and Arguments

Reconsideration is hereby requested, as is a one month extension of time, within which to respond to the non-final Official Action. The Small Entity extension of time fee for one month in the amount of \$55.00 is to be charged to Deposit Account No. 502557.

Claims 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 3, line 2, "said male members" has been clarified by amended Claim 1, to provide proper antecedent basis.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Application (JP 11-190026) in view of Nanayakkara (US 6,105,330). A determination under 35 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obvious determination is based on certain underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

It is important to note that, for an application to be anticipated under §102, every element of a patent claim must appear in a single reference. *Genzyme*

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Corp. v. Atrium Med. Corp., 315 F. Supp. 2d 552; 2004 U.S. Dist. LEXIS 10984,

21 (2004). Other references, and opinions, may be used to elaborate what the reference would have meant to those of skill in the art at the time of the invention.

Id. One, must identify the claimed elements, determine their meaning in light of the specification and prosecution history, and identify those same elements in the anticipating reference. Id.

It is error to treat the claims as a mere catalog of parts, disregarding part-to-part inter-relationships that give claims their meaning. Id. Experts often use the same words to describe the same device and a prior art reference. Id. However, whether the terms are used in different ways to connote different intended functions is often the issue. Id. The prior art cannot anticipate or render obvious a claim simply by possessing identically named parts, unless these parts also have the same structure which function in the same way to achieve the same or a related result. *Genzyme* at 21.

In line with this standard, case law provides that a first requirement is a suggestion, teaching, or motivation to functionally combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999). The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success in the

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intended purpose. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673,

1681 (Fed. Cir. 1988). The mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

With regard to the cited Japanese Patent Application, the reinforcing material there is made of a geotextile. A geotextile can be defined as a woven or knit cloth. The Japanese Patent Application utilizes this geotextile because it is flexible and can be placed between a variety of different blocks regardless of the geometry of the interface. However, the Applicant's invention utilizes a "geo-grid" which is much stronger than the geotextile. The geo-grid is comprised of a heavy wire and is substantially more rigid. The geo-grid is also block specific and can only be used with a specific geometry of the interface. This inherently gives much more reliable positioning and therefore a more stable and rigid retaining wall.

In view of Nanayakkara, the block system is similar. However, the prior art does not use a geometry-specific rigid geo-grid to enhance the reinforcement and stability of the retaining wall.

In the instance that there may exist a double patenting issue, the Applicant will consider a terminal disclaimer.

In view of the above, Applicant urges amended Claims 1-5 are now allowable in that all objections of record have been satisfactorily responded to.

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Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims
1-5, as amended.

Respectfully submitted,
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Date of Signature

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